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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/780,230	02/09/2001	Andreas Manz	0225-0066.22	8918

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EXAMINER	
STARSIAK, JOHN S	

ART UNIT	PAPER NUMBER
1753	4

DATE MAILED: 03/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

mk-4

Office Action Summary	Application No. 09/780,230	Applicant(s) Andreas Manz et al
	Examiner J. STARSIAK	Group Art Unit 1753

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

☒ Responsive to communication(s) filed on 09 February 2001.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 19-21 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 19-21 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☐ All ☐ Some* ☐ None of the:

☐ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. _____.

☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____.

Attachment(s)

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3

☐ Interview Summary, PTO-413

☒ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other _____

Office Action Summary

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 19 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Verheggen et al.

Figure 1 of Verheggen et al. clearly illustrates all of the structure recited in claim 1. Figure 1 all illustrates all of the process language in claim 19 except for what is causing fluid flow. On page 622, Verheggen et al. teaches, "In a third experiment (fig. 3c) the sampling was carried out by electromigration.

Claim 19 is rejected under 35 U.S.C. 102(a) as being clearly anticipated by Effenhauser et al..(Analytical Chemistry, 65) or Carlo S. Effenhauser (Analytical Methods and Instrumentation).

Claim 19 clearly reads on these articles since the author(s) of these articles are is(are) the applicants of the present invention.

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 19-21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1,4, and 5 of U.S. Patent No. 6,423,198. Although

the conflicting claims are not identical, they are not patentably distinct from each other because the only difference between the claims in U.S. Patent No. 6,423,198 and the claims in the present application is that the claims in U.S. Patent No. 6,423,198 also recite, "applying an electric field across said supply and drain channels for a period which is at least long enough, such that the injected sample plug reflects the original sample composition". In the present situation the three principles set forth apply, i.e., 1) the subject matter claimed in the application was fully disclosed in the earlier filed application, 2) the patent protection already granted in the earlier filed application would be extended by the allowance of the claims in the later filed application, 3)there is no apparent reason why the applicant was prevented from fully prosecuting the present claims in the parent application.

Response to Arguments

Applicant's arguments filed 03 February 2001 have been fully considered but they are not persuasive.

Applicant's argument that Verheggen et al., "fails to *recognize the benefit* of manipulating the supply and drain channel intersections with the electrolyte channel to form a geometrically defined sample volume between the supply and drain ports. This argument is not well-taken for several reasons. First, the applicant fails to point out where this limitation is recited in the claims. Second, the applicants admit in their article in Analytical Chemistry that, "the first demonstration

of the volume defined injection principle to prevent sample biasing was given by Verheggen et al.."

Applicant's argument that "Verheggen et al advises against the use of an electrokinetic technique to introduce the sample because such electrokinetic techniques do not result in the introduction of representative sample aliquots" is not well-taken for the following reasons. First, this argument does not change the fact that Verheggen et al. did preform the claimed process. Second, Verheggen et al. only advise against using electromigration in quantitative analysis. In qualitative analysis (wherein only an indication of the presence of a particular species is required) electromigration is the simplest method of sample introduction (e.g. no moving parts).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John S. Starsiak Jr. whose telephone number is (703) 308-1797. The examiner can normally be reached on Monday to Wednesday from 8:00 AM to 3:30 PM and on Wednesday and Thursday from 8:00 AM to 12:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam X. Nguyen, can be reached on (703) (703) 308-3322 . The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

NAM NGUYEN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

John S. Starsiak Jr.

06 March 2003